THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCIS J. CUNNANE III and H. THOMAS SANDERS

Appeal No. 1996-2961
Application No. 08/342,827

HEARD: April 19, 2000

Before KIMLIN, WALTZ and KRATZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 15-19, 21-23 and 25. Claim 15 is illustrative:

15. A wet press felt comprising:

a woven base fabric having a paper carrying side; said base fabric including a first system of yarns interwoven with a second system of yarns;

said first system yarns being hollow, synthetic monofilament yarns having an O-shaped cross-section and an internal core void of at least 16%, being compressible from a substantially round cross-section to a fully flattened cross-section when subjected to nip pressures of at least 200 psi, and being sufficiently resilient to rebound to an uncompressed state after passing through a press nip; and

said base fabric being woven and finished such that in said finished base fabric:

portions of said first system yarns which contact said second system yarns have at least a partially flattened cross-section, and

said first system yarns remain substantially unflattened in cross-section thereby defining resiliently compressible cushioning for enhancing wet press felt performance in dewatering an aqueous paper web through a press nip.

The examiner has not applied prior art in the rejection of the appealed claims.

Appealed claims 15, 16, 23 and 25 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 15-19, 21-23 and 25 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,368,696.

The present application is a continuation of U.S. Application No. 07/955,513, filed October 2, 1992. The parent application issued as Patent No. 5,368,696. This patent is the basis for the examiner's double patenting rejection.

We consider first the examiner's rejection of claims 15, 16, 23 and 25 under 35 U.S.C. § 112, first paragraph. According to the examiner, "the disclosure is enabling only for claims limited having hollow yards [sic, yarns] predominate on the paper carrying side of the fabric" (page 4 of Answer). The examiner goes on to say at page 5 of the Answer that "[t]he hollow yarns predominating the paper side of the fabric appears to be an essential feature of the invention as disclosed in the specification."

It is well settled that the examiner has the initial burden of establishing lack of enablement by setting forth compelling reasoning or objective evidence that one of ordinary skill in the art would not be able to practice the claimed invention in light of the supporting specification. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). In the present case, the examiner has not satisfied her burden of demonstrating that one of ordinary skill in the art would be unable to make a wet press felt comprising a base fabric including a first system of hollow, synthetic monofilament

yarns that are not predominant on the paper carrying side of the fabric. On the other hand, appellants have cited U.S. Patent No. 4,883,097 for evidence that one of ordinary skill in the art would have been able to do so. To the extent the examiner's rejection is based upon the description requirement of § 112, first paragraph, we find that the presently claimed invention is adequately described at page 3 of the specification, first paragraph.

We now turn to the examiner's rejection of claims 15-19, 21-23 and 25 under the judicially created doctrine of obviousness-type double patenting. Appellants have not presented a substantive argument why the appealed claims would not have been obvious to one of ordinary skill in the art in view of the patented claims of the parent application. Appellants merely submit that "the assertion that claim 15 is obvious in view of issued claim 6 is inconsistent with the rejection of claim 15 under §112, first paragraph" (page 8 of Brief). We note that "applicants are willing to submit a terminal disclaimer to render moot the obvious-type double patenting rejection" (page 8 of Brief). Accordingly, we will sustain the examiner's rejection.

In conclusion, the examiner's double patenting rejection is affirmed. The examiner's rejection under 35 U.S.C. § 112, first paragraph, is reversed. The examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

EDWARD C. KIMLIN Administrative Patent Judge	)	
THOMAS A. WALTZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PETER F. KRATZ Administrative Patent Judge	)	

ECK:clm

Volpe and Koenig
400 One Penn Center
1617 John F. Kennedy Blvd.
Philadelphia, PA 19103